REMARKS/ARGUMENTS

The applicant respectfully requests further examination and consideration in view of the arguments set forth fully below. Prior to this Office Action, Claims 1-49 were pending in this application. Claims 1-49 stand rejected in a non-final Office Action under 35 U.S.C. 103(a). In this Response, no claims were amended and no claims were canceled. Accordingly, claims 1-49 are currently pending in this application.

I.   CLAIM REJECTIONS UNDER 35 U.S.C §103(a)

Within the Office Action, Claims 1-49 are rejected under § 103(a) as being obvious over Ng (U.S. Patent No. 6,405,175) (hereinafter *Ng*) in view of Morton (U.S. Patent No. 6,327,572) (hereinafter *Morton*) and further in view of Capiel (U.S. Patent No. 6,449,634) (hereinafter *Capiel*). The applicant respectfully traverses.

In brief, the present invention passes certain identifying information from a vendor to a satisfied customer in an e-mail that the satisfied customer can forward to a potential customer. That information can be a serial number, a URL link, or a token.

Ng teaches a web site on the word-wide-web that allows users to search a product/price database. The searcher accesses the searchable database through a webpage search form. Information in the database is collected and corrected by submitting users who are rewarded for product submissions. The submitting user accesses the data-entry module through a webpage entry form and the information is then stored in the appropriate location in the database after verification. Additionally, a record of the rewards earned by submitting users is stored in their account record in the database.

Morton teaches a method for rewarding merchants when a consumer accesses the website of a paying merchant through the first merchant's servers. The paying merchant will reward the first merchant for the "traffic" directed to the website of the paying merchant via hyperlinks

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located on the website of the first merchant. Additional servers, operated by a service, automatically track and distribute any reward provided by a paying merchant.

Capiel teaches a method and system for determining the file format that an e-mail client is able to process and display through an e-mail sensor message. The e-mail sensor message is then received by an e-mail sensor server which is maintained by the merchant. The e-mail sensor server will then save information about the e-mail client to an e-mail sensor server database. The information saved to the e-mail sensor sever database will then be used to ensure that any subsequent e-mails sent to a customer via their e-mail client are in the appropriate file format.

None of the recited limitations of independent claims 1 and 46 is taught or suggested by *Ng*, *Morton* and *Capiel*, individually or in combination. Claim 1 has elements (a) through (e). The designation of the sub-paragraphs of (a) through (e) are included for convenience and not intended to limit the scope of the claims. In claim 1, element (a) of "creating a digital data base controlled by a Provider" is not present in *Ng* since in *Ng*, a searchable product/price data base is controlled by consumers, rather than by a provider. Consumers in *Ng* "build and maintain the information in the database" for products with the lowest price (col. 13, ll. 23-34). In *Morton*, there is no creation of a database by the provider, a customer's existing contact database is used by the information system to identify potential customers. Element (a) is also not present in *Capiel*. The e-mail sensor server database is maintained on the merchant's own e-mail sensor server, and therefore, a provider does not control the database.

Element (b) of claim 1 of "offering a potential reward to a first party in exchange for promotional assistance of the first party, the promotional assistance comprising assistance in a forwarding of a first e-mail message to a second party, the first e-mail message comprising a personalized referral for the marketable entity, and a first set of data comprising a first serial number and a first URL link" is also not taught or suggested by *Ng*, *Morton* and *Capiel*, individually or in combination. *Ng* does not utilize e-mail and *Ng* does not teach nor suggest a first e-mail message with a personalized referral and a first set of data comprising a first serial

number and a first URL link. *Morton* also does not teach or suggest element (b) of claim 1, as *Morton* does not offer potential rewards for a forwarding of an e-mail comprising a personalize referral and a first set of data comprising a first serial number and a first URL link. Further, *Capiel* does not offer protential rewards for forwarding an e-mail to a second party; the information sent in the email is strictly for the benefit of the receiver.

Element (c) of claim 1 of "creating a first Web site corresponding to the first URL link, the first Web site providing information on the referenced marketable entity and an offer to transact for the referenced marketable entity" is also not taught nor suggested by *Ng, Morton* and *Capiel*, individually or in combination. Element (c) refers to the first URL link previously introduced in element (b) of claim 1. As set forth above, neither *Ng, Morton* nor *Capiel* utilize e-mail that comprises a first set of data comprising a first serial number and a first URL link. *Ng* does not create a first website corresponding to a first URL link in a first e-mail. Also, the provider's website in *Ng* does not have an offer to transact for a marketable entity. It is merely a clearinghouse of hyperlinks to other outside merchants' webpages which do have offers to transact for the marketable entities. Further, the element is not present in *Morton* as there is no creation of a website corresponding to a first URL link in a first e-mail with a personalized referral. In *Morton*, the information system itself via telephone contact offers to potential customers to become subscribers of the system. In addition, the element is not present in *Capiel* as the HTML link in the email messages sent out connects the recipient of the merchant's homepage, not a webpage created specifically for the receiver and the product that is being marketed. Hence, element (c) of claim 1 is also not taught nor suggested in *Ng, Morton* and *Capiel*, individually or in combination.

Element (d) of claim 1 of "correlating the first set of data in the first e-mail message to a first set of database data within the database, including data within the database relating to the potential reward offered to the first party in exchange for promotional assistance" is not taught nor suggested by *Ng, Morton* and *Capiel*, individually or in combination. *Ng* does not utilize e-

mail messages and does not correlate data found in e-mail messages to database data or to data relating to a potential reward. *Morton* does not offer a potential reward and does not correlate data in a first e-mail to database data. The database in *Capiel* is used only to store the file format that an email client can display, not the actual contents of the email. *Capiel* does not correlate data in the email to database data. Therefore, element (d) of claim 1 is also not taught nor suggested in *Ng, Morton* and *Capiel*, individually or in combination.

Finally, element (e) of claim 1 of "forwarding the first e-mail message to a second party" is not taught or suggested by *Ng, Morton* and *Capiel*, individually or in combination. *Ng* does not utilize or forward e-mail messages to second parties. As mentioned before, *Morton* does not utilize a first-email message comprising a personalized referral, a URL link and a first data. In addition, *Capiel* does not teach that the e-mail messages could be forwarded to second parties.

Similarly for independent claim 46, the combination of claimed limitations are not taught or suggested by *Ng, Morton* and *Capiel*, individually or in combination. Specifically, element (c) of claim 46 of "forwarding an e-mail to a second party, the e-mail comprising a recommendation for the second marketable entity and a URL link to a Web site" is not taught or suggested by *Ng, Morton* or *Capiel*, individually or in combination. *Ng* does not utilize e-mails. *Morton* and *Capiel* do not provide a forwarding of a first e-mail to a second party, where the e-mail is a recommendation to a second marketable entity with a URL link to a website.

In view of the arguments stated above, independent claims 1 and 46 are allowable. Furthermore, dependent claims 2-45 and 47-49 depend from independent claim 1, an allowable base claim. For at least these reasons, Applicant respectfully submits that claims 1-49 are allowable.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact the undersigned at (408) 530-9700.

Respectfully submitted,

HAVERSTOCK & OWENS LLP

Dated: _June 1, 2004_   By: _____
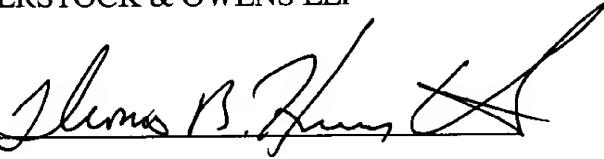
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CERTIFICATE OF MAILING (37 CFR§ 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

HAVERSTOCK & OWENS LLP.

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